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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.               | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------------|------------------|
| 10/822,044   | 04/09/2004  | Ronald R. Erickson   | 2003-02PAT                        | 2270             |
| 7590 09/09/2004<br>Sills, Cummis Radin, Tischman,<br>Epstein & Gross, P.A.<br>One Riverfront Plaza<br>Newark, NJ 07102 |             |                      | EXAMINER<br>BOUTSIKARIS, LEONIDAS |                  |
|  |             |                      | ART UNIT<br>2872                  | PAPER NUMBER     |

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/822,044 | <b>Applicant(s)</b><br>ERICKSON ET AL. |  |
|                              | <b>Examiner</b><br>Leo Boutsikaris   | <b>Art Unit</b><br>2872                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 4 cite a holographic element “[including] a first layer of optical information in a first coded pattern and a second layer of optical information in a second coded pattern” which is confusing. Specifically, it is not clear whether the above language refers to a case where there are provided two separate holographic layers within the carrier, each layer having a separate information, or it refers to the case where there is provided one holographic layer within

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the carrier, the single holographic layer being such that it provides two different layers of optical information in space, upon viewing using a light source. For examination purposes, the latter case will be assumed.

Claims 2-3, 5-6 inherit the deficiency of claims 1 and 4 from which they depend.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Daniel (US 6,280,891).

Regarding claim 1, Daniel discloses a device for limiting the reproducibility of information in the form of a security hologram affixed to a document (Figs. 1, 3) comprising a semi-rigid carrier 1; and a holographic element 4 coupled to the carrier (Figs. 2, 4), the holographic element being such that upon viewing, it provides a first layer of optical information in a first coded pattern 16 (e.g., a bar code), see Fig. 6, and a second layer of optical information in a second coded pattern 17 (e.g., a bar code), see Fig. 7 (lines 53-58, col. 4, 21-48, col. 5, 12-48, col. 6).

Regarding claims 2-3, the patterns 16, 17 are identifiers, coded according to a secret coding function/algorithm, which may be the same or different depending on the document (lines 24-32, col. 6).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel (US 6,280,891) in view of Jung (US 4,171,864).

Regarding claim 4, Daniel discloses all the limitations of the above claim including a reader system, which includes a light source 17, a first and a second detector positioned at respective predetermined distances from the location of the holographic element (provided on the surface of carrier 3), the detectors being provided on CCD sensor 18 (Fig. 8, lines 44-56, col. 6). Each detector corresponds to a respective angle of incidence for the reading light. However, Daniel does not specify that the reader system comprises a reader housing having an opening where the holographic element/carrier is positioned. Jung discloses an identification security document and a display system for reading it (Fig. 5), wherein the security hologram 10 is positioned inside an appropriate reader apparatus 17 through an opening (see Fig. 5, and lines 25-46, col. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to read the security document 3 of Daniel via a reader device as taught by Jung, for achieving a robust reader device ensuring the same optical alignment each time the document is read.

Regarding claim 5, the reader apparatus utilizes a microcomputer (lines 52-56, col. 6 in Daniel).

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Regarding claim 6, the first and second detectors comprise arrays of detectors in the form of a CCD array 18 (lines 52-54, col. 6).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Leo Boutsikaris whose telephone number is 571-272-2308.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Leo Boutsikaris, Ph.D.  
Patent Examiner, AU 2872  
September 6, 2004

A handwritten signature in black ink, consisting of stylized initials 'LB'.